

REMARKS

This responds to the Office Action mailed on June 21, 2006.

Claim 16 was amended, no claims are canceled, and no claims are added; as a result, claims 1-35 are now pending in this application.

Double Patenting Rejection

Claims 1, 16, 30, 32 and 34 were rejected under the judicially created doctrine of obviousness-type double patenting over claims 1 and 2 of co-pending application 10/117,868. Applicant does not admit that claims are obvious in view of co-pending application 10/117,868. However, a Terminal Disclaimer in compliance with 37 CFR 1.321(b)(iv) is enclosed herewith to obviate these rejections.

§102 Rejection of the Claims

Claims 1-3, 6, 9, 13-14, 16-18, 21, 24, 28, 30, 32 and 34 were rejected under 35 U.S.C. § 102(b) for anticipation by Grootwassink (U.S. 7,031,705, hereinafter, "Grootwassink").

Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration. *In re Dillon* 919 F.2d 688, 16 USPQ 2d 1897, 1908 (Fed. Cir. 1990) (en banc), cert. denied, 500 U.S. 904 (1991). It is not enough, however, that the prior art reference discloses all the claimed elements in isolation. Rather, "[a]nticipation requires the presence in a single prior reference disclosure of each and every element of the claimed invention, *arranged as in the claim*." *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)) (emphasis added).

Applicants respectfully submits that the Office Action did not make out a *prima facie* case of anticipation for at least the following reasons:

The reference does not teach each and every claim element.

To anticipate a claim, the reference must teach every element of the claim. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of*

California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Claim 1 recites:

“receiving client device configuration data from the client access device over the communications link during an authentication and authorization exchange; transmitting the client device configuration data destined for the second service access provider, wherein the second service access provider is operable to process the client device configuration data and selectively grant the client access device access to the network based upon the client device configuration data; and receiving an indication about whether the client access device is granted access to the network, the indication originating from the second service access provider.” (Emphasis Added)

The Office action cites the following quotes from Grootwassink:

“As shown in FIG. 1, generally in validation, when a wireless unit initiates a communication in a visited service area, the visited system service provider attempts to find the wireless unit's identification (also referred to as registration information) in the visitor location register (VLR) of an appropriate MSC in the visited system (MSC-V). If the VLR lacks the required information, it queries the roamer's home location register ("HLR") in the roamer's home system via a registration notification "REGNOT" request, which includes the wireless unit's identification (e.g., mobile number, its electronic serial number (ESN), and/or mobile identification number (MIN)). . . . then the HLR validates the wireless unit with a message to the serving VLR in the visited system, . . . After the serving VLR in the visited system receives that message, it lets the subscriber use the local network.” (Col. 2, lines 47-67) (Emphasis Added)

“Validation data: refers to the data necessary to reach a conclusion as to whether a network should allow a user access. Such data includes authentication of the user's mobile phone number as well as user profile data indicating whether the user has paid bills, etc.” (Col. 5, lines 6-10) (Emphasis Added)

Grootwassink teaches letting the subscriber use the local network after the VLR in the visited system receives the message (validation of the wireless unit) from the roamer's home location register (HLR). However, as the Examiner correctly states “Grootwassink does not disclose expressly the second service access provider” (Page 6, paragraph 5); in addition, Grootwassink does not disclose granting the client access device access to network based upon client device configuration such as security settings (e.g., antivirus software status, firewall status, etc.) (See application, paragraph 00057). In other words, Grootwassink fails to teach “*selectively grant the client access device access to the network based upon the client device configuration data; and receiving an indication about whether the client access device is granted access to the network, the indication originating from the second service access provider.*”, as recited in claim 1. As such, Grootwassink does not teach/suggest each and every element of claim 1, thus does

not anticipate it. Therefore, Applicants submit that at least for the above reason, claim 1 and its direct/indirect dependent claims 2-15 are allowable.

With respect to claim 16, as mentioned above, Grootwassink does not disclose the second service access provider and is also silent on receiving client device configuration from the service access provider and processing such configuration data. In other words, Grootwassink fails to teach claim 16 limitations “*a second service access provider to receive the authentication information and the configuration data from the first service access provider, to process the configuration data, and to selectively grant the client access device access to the network based upon the configuration data*” and “*a second service access provider to receive the authentication information*”. As such, Grootwassink does not teach/suggest each and every element of claim 16, thus does not anticipate it. Therefore, Applicants submit that at least for the above reason, claim 16 and its direct/indirect dependent claims 17-29 are allowable.

Independent claims 30, 32, and 34 include substantially the same features as claim 1. As such, at least for the same reason set forth above these claims and their dependent claims 33 and 35 are allowable and it is requested that their rejections under 35 U.S.C. § 102(b) be withdrawn.

§103 Rejection of the Claims

Claims 4-5, 7-8, 10-12, 15, 19, 20, 22, 23, 25-27, 29, 31, 33 and 35 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Grootwassink in view of Albert et al. (U.S. 2003/0177389, hereinafter, “Albert”).

Applicant respectfully submits that the Office Action did not make out a *prima facie* case of obviousness for the following reasons:

(1) even if combined, the cited references fail to teach or suggest all of the elements of Applicant’s claimed invention;

The reference (or references when combined) must teach or suggest all the claim elements. M.P.E.P. § 2142 (citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir. 1991)).

Claims 4-5, 7-8, 10-12, 15, 19, 20, 22, 23, 25-27, 29, 31, 33 and 35 depend directly or indirectly from Independent claims 1, 16, 30, 32, and 34 discussed above and inherit from them the same limitation which is missing in Grootwassink, therefore, for these claims to be anticipated by the combination of Grootwassink and Albert, Albert should provide what is missing in Grootwassink.

Albert is directed at a system providing methods for a device to apply a security policy required for connection to a network. (Abstract) Albert specifically describes:

The system provides methods for a computing system or device to apply a security policy required for connection to a network from a plurality of security policies available for governing connections. In response to receipt of a request from a device for connection to a particular network, a current policy to apply to said device for governing the connection to this particular network is determined from a plurality of available security policies. The current policy to apply to said device is generated by merging a plurality of security policies available for governing connections. After said current policy is applied to the device, the connection from the device to this particular network is allowed to proceed." (Paragraph 0025)

Albert teaches determining a current security policy and applying it to the device and allowing the connection from the device to a network after said policy is applied to the device. However, Albert does not teach "a second service access provider"; specifically it fails to teach "*selectively grant the client access device access to the network based upon the client device configuration data; and receiving an indication about whether the client access device is granted access to the network, the indication originating from the second service access provider.*", as recited in claim 1; and "*a second service access provider to receive the authentication information and the configuration data from the first service access provider, to process the configuration data, and to selectively grant the client access device access to the network based upon the configuration data.*", as recited in claim 16. As such, Grootwassink and Albert, independently or in combination, fail to teach/suggest each and every element of claims 1, and 16. Claims 30, 32, and 34 include substantially the same features as in claim 1. Therefore, Applicants respectfully submit that at least for the same reasons noted above, claims 1, 16, 30, 32, and 34 and their direct/indirect dependent claims 4-5, 7-8, 10-12, 15,

19, 20, 22, 23, 25-27, 29, 31, 33 and 35 are allowable and their rejection under 35 U.S.C.

§ 103(a) should be withdrawn.

Reservation of Rights

Applicants do not admit that documents cited under 35 U.S.C. §§103/102(a), or 103/102(e) are prior art, and reserves the right to swear behind them at a later date. Arguments presented to distinguish such documents should not be construed as admissions that the documents are prior art. Applicants also reserve the right to pursue canceled and originally filed claims in a continuation application. Furthermore, Applicants do not acquiesce to any of the Examiner's assertions about the claims or the cited documents and reserves the right to argue these assertions in the future.

CONCLUSION

Applicants respectfully submit that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicants' attorney 408-278-4042 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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Date 12/18/2006

By


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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop AF, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 18 day of December 2006.

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Signature